

ESTTA Tracking number: **ESTTA594272**

Filing date: **03/24/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	MSC Services Corp.
Granted to Date of previous extension	03/22/2014
Address	75 Maxess Road Melville, NY 11747 UNITED STATES

Name	Sid Tool Co., Inc. (d/b/a MSC Industrial Supply Co.)		
Entity	Corporation	Citizenship	New York
Address	75 Maxess Road Melville, NY 11747 UNITED STATES		

Attorney information	Michael R. Graif Curtis, Mallet-Prevost, Colt & Mosle LLP 101 Park Avenue New York, NY 10178 UNITED STATES trademark@curtis.com Phone:212-696-6000
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Applicant Information

Application No	86025401	Publication date	01/21/2014
Opposition Filing Date	03/24/2014	Opposition Period Ends	03/22/2014
Applicant	ProSource Discounts, Inc. 8943 Oso Avenue Chatsworth, CA 91311 CANADA		


Goods/Services Affected by Opposition


Class 011. First Use: 2013/07/25 First Use In Commerce: 2013/07/25 All goods and services in the class are opposed, namely: Air purifiers; electric griddles; flameless tea light candles
Class 020. First Use: 2010/04/16 First Use In Commerce: 2010/04/16 All goods and services in the class are opposed, namely: Hammock stands; garment and clothing storage racks
Class 022. First Use: 2009/10/07 First Use In Commerce: 2009/10/07 All goods and services in the class are opposed, namely: Fabric products for outdoor shade, namely, shade sails; tents


Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Priority and likelihood of confusion under common law; MSC Services and Sid Tool have rights in the marks that are superior to any rights of the applicant

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4377808	Application Date	04/28/2010
Registration Date	07/30/2013	Foreign Priority Date	NONE
Word Mark	PRO SOURCE THE PROFESSIONAL CHOICE		
Design Mark			
Description of Mark	The mark consists of the wording "PRO" and "SOURCE" separated by two chevron designs and a dash. Each term has three lines underneath with one long line running under both terms. At the bottom of the mark is the wording "THE PROFESSIONAL CHOICE".		
Goods/Services	<p>Class 003. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 Industrial hand soap</p> <p>Class 005. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 Industrial hand sanitizing preparations</p> <p>Class 008. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 Hand operated sprayers for garden use; hand operated atomizers and sprayers for use with industrial liquids; hand-operated lawn and gardening equipment and tools, namely, shovels, scoops, scrapers, rakes, pruning tools, namely, scissors and shears and, pitch forks</p> <p>Class 016. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 Paper towels and tissues; paper and plastic garbage bags; plastic trash bags; trash can liners; paper wipers</p> <p>Class 020. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 Fixed non-metal dispensers for wipes and paper towels</p> <p>Class 021. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 Buckets; cloth and nylon reinforced wipers; mopping equipment, namely, cleaning brushes, mops, mop handles, mop buckets and squeegees; waste containment products and equipment, namely, waste baskets, trash cans, dispensers for liquid hand soap and hand sanitizers</p>		
U.S. Registration No.	3773507	Application Date	10/30/2008
Registration Date	04/06/2010	Foreign Priority Date	NONE

Word Mark	PRO SOURCE THE PROFESSIONAL CHOICE
Design Mark	
Description of Mark	The mark consists of the words "PRO SOURCE THE PROFESSIONAL CHOICE" and a design.
Goods/Services	Class 021. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 Janitorial, cleaning, and sanitary supplies and products, namely, cleaning cloths, wiping cloths, cleaning rags, cleaning sponges, mops, brooms, dustpans, cleaning brushes, cleaning scrubbers, cleaning squeegees, and dusters

U.S. Registration No.	4002807	Application Date	10/30/2008
Registration Date	07/26/2011	Foreign Priority Date	NONE
Word Mark	PRO SOURCE THE PROFESSIONAL CHOICE		
Design Mark			
Description of Mark	The mark consists of the words "PRO SOURCE THE PROFESSIONAL CHOICE" and a design.		
Goods/Services	Class 001. First use: First Use: 2010/01/31 First Use In Commerce: 2010/01/31 Chemical compounds used to melt ice and snow		

U.S. Application No.	85025688	Application Date	04/28/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PRO SOURCE THE PROFESSIONAL CHOICE		
Design Mark			
Description of Mark	The mark consists of the wording "PRO" and "SOURCE" separated by two chevron designs and a dash. Each term has three lines underneath with one		

	long line running under both terms. At the bottom of the mark is the wording "THE PROFESSIONAL CHOICE".
Goods/Services	Class 006. First use: First Use: 0 First Use In Commerce: 0 Fixed metal dispensers for wipes and paper towels

Attachments	85979412#TMSN.jpeg(bytes) 77978879#TMSN.jpeg(bytes) 77604301#TMSN.jpeg(bytes) 85025688#TMSN.jpeg(bytes) Pro Source Discounts 86025401.pdf(15631 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ Michael R. Graif
Name	Michael R. Graif
Date	03/24/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. : 86025401
Mark : PROSOURCE
International Classes : 011, 020 and 022
Applicant : ProSource Discounts, Inc.
Filed : July 31, 2013
Published : January 21, 2014

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MSC SERVICES CORP.; SID TOOL CO., INC.	:	
(D/B/A MSC INDUSTRIAL SUPPLY CO.)	:	
	:	
Opposers,	:	
	:	
against	:	Opposition No. _____
	:	
PROSOURCE DISCOUNTS, INC.,	:	
	:	
Applicant.	:	
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NOTICE OF OPPOSITION

MSC Services Corp. and Sid Tool Co., Inc. (d/b/a MSC Industrial Supply Co.), are corporations organized under the laws of the State of New York, located and doing business at 75 Maxess Road, Melville, New York 11747 (the “Opposers”), and believe that they would be damaged by the registration of United States Trademark Application Serial No. 86025401 (the “Application”) for the mark PROSOURCE filed by ProSource Discounts, Inc. (the “Applicant”) on July 31, 2013 and published for opposition on January 21, 2014 in:

International Class 011 and United States Classes 013, 021, 023, 031 and 034 for “Air purifiers; electric griddles; flameless tea light candles” and claiming a date of first use of July 25, 2013;

International Class 011 and United States Classes 013, 021, 023, 031 and 034 for “Hammock stands; garment and clothing storage racks” and claiming a date of first use of April 16, 2010; and

International Class 011 and United States Classes 013, 021, 023, 031 and 034 for “Fabric products for outdoor shade, namely, shade sails; tents” and claiming a date of first use of October 7, 2009.

Opposers hereby oppose the Application.

As grounds for opposition, Opposers assert that:

1. Opposers market, distribute and sell a variety of air filters, electronic air cleaners, storage containers, lawn and garden products, tarps, storage racks, shelving, tools, industrial products, and maintenance, repair and operations products (“MRO products”) throughout the United States. In particular, Opposers market, distribute and sell a variety of products under the mark PRO SOURCE, including lawn and garden products, containers, storage hooks, cleaning supplies, brushes, storage bags and MRO products.
2. Opposers have continuously made commercial use of PRO SOURCE as a trademark throughout the United States since at least September 1, 2009.
3. Opposers have acquired common law rights in the PRO SOURCE marks by virtue of their continuous use of their PRO SOURCE marks in commerce. Opposers have expended significant amounts of time, money and effort in promoting and advertising their PRO SOURCE marks as well as the products and services distributed, marketed and sold thereunder. Opposers’ PRO SOURCE marks are famous and consumers have come to recognize the PRO SOURCE marks as identifiers of Opposers’ products and services and as a single source of origin.
4. In addition, Opposer MSC Services Inc. owns several federal trademark registrations for its PRO SOURCE marks, and Opposer Sid Tool Co., Inc. is a licensee of each of these registrations.
5. Opposers’ PRO SOURCE THE PROFESSIONAL CHOICE mark was registered with the United States Patent and Trademark Office (“USPTO”) under the U.S. Trademark Registration No. 4,377,808 on October 4, 2011 for:

“Industrial hand soap” in International Class 003 and United States Classes 001, 004, 006, 050, 051 and 052;

“Industrial hand sanitizing preparations” in International Class 005 and United States Classes 006, 018, 044, 046, 051 and 052;

“Hand operated sprayers for garden use; hand operated atomizers and sprayers for use with industrial liquids; hand-operated lawn and gardening equipment and tools, namely, shovels, scoops, scrapers, rakes, pruning tools, namely, scissors and shears and, pitch forks” in International Class 008 and United States Classes 023, 028 and 044;

“Paper towels and tissues; paper and plastic garbage bags; plastic trash bags; trash can liners; paper wipers” in International Class 016 and United States Classes 002, 005, 022, 023, 029, 037, 038 and 050;

“Fixed non-metal dispensers for wipes and paper towels” in International Class 020 and United States Classes 002, 013, 022, 025, 032 and 050; and

“Buckets; cloth and nylon reinforced wipers; mopping equipment, namely, cleaning brushes, mops, mop handles, mop buckets and squeegees; waste containment products and equipment, namely, waste baskets, trash cans, dispensers for liquid hand soap and hand sanitizers” in International Class 021 and United States Classes 002, 013, 023, 029, 030, 033, 040 and 050.

This registration recites a date of first use in commerce at least as early as September 1, 2009 for all products and services listed therein.

6. Opposers’ PRO SOURCE THE PROFESSIONAL CHOICE mark was registered with the USPTO under the U.S. Trademark Registration No. 3,773,507 on April 6, 2010 for “Janitorial, cleaning, and sanitary supplies and products, namely, cleaning cloths, wiping cloths, cleaning rags, cleaning sponges, mops, brooms, dustpans, cleaning brushes, cleaning scrubbers, cleaning squeegees, and dusters” in International Class 021 and United States Classes 002, 013, 023, 029, 030, 033, 040 and 050, and recites a date of first use in commerce at least as early as September 1, 2009.

7. Opposers' PRO SOURCE THE PROFESSIONAL CHOICE mark was registered with the USPTO under the U.S. Trademark Registration No. 4,002,807 on July 26, 2011 for "Chemical compounds used to melt ice and snow" in International Class 001 and United States Classes 001, 005, 006, 010, 026 and 046, and recites a date of first use in commerce of January 31, 2010.

8. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 85025688 for the mark PRO SOURCE THE PROFESSIONAL CHOICE for "Fixed metal dispensers for wipes and paper towels" in International Class 006 and United States Classes 002, 012, 013, 014, 023, 025 and 050. Opposer MSC Services filed this application on April 28, 2010 and the USPTO published it for opposition on October 4, 2011.

9. Upon information and belief, Applicant is a corporation organized under the laws of the State of California and is located and doing business at 8943 Oso Avenue Unit C Chatsworth, California 91311.

10. The Applicant's PROSOURCE mark is identical or confusingly similar to the Opposers' PRO SOURCE marks.

11. Opposers use the PRO SOURCE marks in connection with marketing, distributing and selling products and services that are substantially similar and/or related to the goods and services listed in the Application.

12. In view of Opposers' use of the PRO SOURCE marks before the dates of first use claimed in the Application, Opposers have rights in the PRO SOURCE and PROSOURCE marks that are superior and have priority to those of the Applicant.

13. If the Application is not withdrawn or amended so as to avoid a likelihood of confusion with Opposers' MSC marks, Opposers will suffer damage to their goodwill and

reputation, and the public is likely to be confused or deceived with respect to the source, origin, connection, affiliation, sponsorship or approval of Applicant's goods and/or Opposers' affiliation, sponsorship or connection with Applicant.

14. By reason of all of the foregoing, issuance of a registration to Applicant with respect to the Application would seriously damage Opposers.

WHEREFORE, Opposers pray that this opposition be sustained and that Application Serial No. 86025401 for the MSC mark be refused registration.

Respectfully submitted,

MSC Services Corp., Sid Tool Co., Inc.
(d/b/a MSC Industrial Supply Co.)

Dated: New York, New York
March 24, 2014

By: /s/ Michael R. Graif
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